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EXAMINER				
GOFF II, JOHN L				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* BERNHARD MUSSIG

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Appeal 2009-2603  
Application 09/156,886  
U.S. Patent Publication 2001/0004494  
Technology Center 1700

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Decided<sup>1</sup>: April 14, 2009

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*Before:* FRED E. McKELVEY, *Senior Administrative Patent Judge*,  
and RICHARD E. SCHAFER and RICHARD TORCZON, *Administrative  
Patent Judges*.

McKELVEY, *Senior Administrative Patent Judge*.

DECISION ON APPEAL

1

2       A. Statement of the case

3       Mussig and the real party in interest (tesa AG—formerly Beirsdorf  
4 AG) (Mussig), seek review under 35 U.S.C. § 134(a) of a final rejection  
5 (mailed 18 March 2005).

6       Claim 37-55 are in the application.

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

1           The Examiner relies on the following prior art:

Dobashi	5,643,676	1 Jul 1997
Koga	EP 0 661 364 A2	7 May 1995

2

3           We have jurisdiction under 35 U.S.C. § 134(a).

4

5           B. Discussion

6           Claims 37-55 are on appeal.

7           Claim 37 is an independent claim.

8           Claims 38-55 are dependent claims.

9           Claim 37, reproduced from the Claims Appendix of the Corrected

10          Appeal Brief (filed 12 Dec. 2006), reads [bracketed matter, italics and some  
11          indentation added]:

12                           A method

13                                   [1] for protecting the paint finish of a vehicle or

14                                   [2] for protecting a painted vehicle component

15                           against soiling and damage during assembly, transportation or  
16                           storage,

17                           said method comprising applying to said vehicle or

18                           vehicle component a self-adhesive protective film,

19                           said self-adhesive protective film comprising:

20                           a) a backing film; and

21                           b) an adhesive composition coated on said backing film,

1                    wherein the adhesive composition comprises [1] a  
2                    copolymer of at least two different  $\alpha$ -olefins having 2 to 12  
3                    carbon atoms and [2] at least one further comonomer,  
4                    said *further comonomer being a diene*,  
5                    said adhesive composition not containing 75 mol-% or  
6                    more of any single  $\alpha$ -olefin,  
7                    the copolymer having a Mooney viscosity ML (1+4) 125  
8                    °C of less than 50.

9                    The rejection is based on the combined disclosures of Koga and  
10                  Dobashi.

11                  One element of the claimed method is the use of an adhesive  
12                  composition comprising [1] a copolymer of at least two different  $\alpha$ -olefins  
13                  having 2 to 12 carbon atoms and [2] at least one further comonomer, said  
14                  further comonomer being a diene.

15                  Mussig maintains (Reply Brief, page 2), and we agree, that Koga does  
16                  not describe a composition having a copolymer wherein at least one further  
17                  comonomer is a diene. The Examiner does not rely on Dobashi for a  
18                  teaching of the further comonomer.

19                  Suitable dienes are those common for the preparation of EPDM  
20                  rubber, examples being (1) 1,4-hexadiene, (2) dicyclopentadiene or, in  
21                  particular, (3) 5-ethylidene-2-norbornene (ENB). The proportion of diene in  
22                  the polymer is preferably between 0.5 and 10% by weight. Specification,  
23                  page 2:14-18.

1           What Koga describes is an adhesive comprising a mixture of (1) a  
2 copolymer of various  $\alpha$ -olefins and (2) certain polymers made *inter alia*  
3 from butadiene—which is a diene.

4           After considering Koga as a whole, including the portions of Koga  
5 cited in the Examiner's Answer, insofar as we can tell nothing in Koga  
6 describes a copolymer made from two  $\alpha$ -olefins monomers and a diene  
7 *monomer*.

8           An essential element of claim 37 being missing from the prior art  
9 relied upon by the Examiner, renders the Examiner's obviousness holding  
10 unsupported factually by the evidence.

11           Claims 38-55 are dependent directly or indirectly on independent  
12 claim 37. If broad claim 37 is not unpatentable over prior art relied upon by  
13 the Examiner, then narrower claims 38-55 likewise cannot be unpatentable  
14 over that prior art.

15           Our rationale for reversal makes it unnecessary to consider the  
16 "evidence" offered by Mussig to allegedly show "unexpected results." See  
17 Appeal Brief, pages 9-15.

18           C. Decision

19           Upon consideration of the appeal, and for the reasons given herein,  
20 it is

21           ORDERED that the decision of the Examiner rejecting  
22 claims 37-55 over the prior art is *reversed*

REVERSED

Appeal 2009-2603  
Application 09/156,886

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